

## REMARKS

Pages 4, 5 and 20 have been replaced to correct for the following informalities: (1) remove highlighting; (2) replace attorney docket number “SEA 2758” with the patent number; and (3) change  $\mu$ ” to  $\mu$ -inch.

Claims 1, 3, 6, 9-16 and 20 were rejected as being anticipated by Bian. This rejection is respectfully traversed and should be withdrawn because pending independent claims 1 and 11 contain the limitation of claim 2, now canceled.

Claim 2, whose limitations are now incorporated in claim 1, has been rejected as being obvious over Bian in view of Okumura, Lal and “applicants’ admissions.” This rejection is respectfully traversed.

The Examiner acknowledges that Bian fails to disclose that “the non-magnetic substrate is mechanically textured and OR-Mrt is more than about 1.05.” The Examiner seems to have recognized, but has not explicitly stated, that Bian discloses an isotropic media, *not* an oriented media. Thus, Bian’s media has an OR-Mrt value of 1.0, *not* more than 1.0, in particular, not more than about 1.05 as recited in claims 1 and 11.

The Examiner attempts to fill this gap in Bian by resorting to Okumura, Lal and “applicants’ admissions.” Applicants respectfully submit that there are several deficiencies in the combination of Bian with the secondary references as proposed by the Examiner. These deficiencies, which would be recognized by persons of ordinary skill in this art, are the following:

(1) The Examiner cites column 6, lines 56-60 of Okamura for disclosing that “examples having mechanical texture show increased anisotropy and improved coercive force.” This statement provides *no* indication as to how this “anisotropy,” which is defined in Okamura as OR-Hc, or coercive force, relates to OR-Mrt. Persons of ordinary skill in this art generally know that there is *no* correlation between OR-Hc, or coercive force, and OR-Mrt. The Examiner has

not provided any evidence showing such a correlation. Even neither Lal nor “applicants’ admission” on page 6, lines 3-16, provide any evidence to this effect.

On the issue of combining references, the Federal Circuit in *In re Sang Su Lee*, 277 F.3d, 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), specifically states, “The need for specificity pervades this authority … [and] *particular findings must* be made as to the reason the skilled artisan, with *no* knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” [Citations omitted; emphasis added.] In light of the decisions of *In re Sang Su Lee* and *In re Zurko*, 258 F.3d 1379, 1385 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), MPEP 2144.03 specifically states, “It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” [Emphasis in original.]

Furthermore, MPEP 2144.03 states, **“If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence.”** The Applicants respectfully challenge the Examiner to provide evidence showing a correlation between OR-Hc, or coercive force, and OR-Mrt.

(2) As explained above, Bian’s media *with RuAl underlayer* have a OR-Mrt of 1.0 because they are isotropic media. There is no suggestion in either Bian or any of the secondary references cited by the Examiner that a RuAl underlayer can even produce an OR-Mrt of greater than 1.0. Okamura, which is cited for disclosing that “examples having mechanical texture show increased anisotropy and improved coercive force,” uses a Cr underlayer having a bcc structure to produce an oriented media. A RuAl underlayer has a B2 structure, which is totally different from a bcc structure. Nowhere does any of the cited references disclose that a RuAl underlayer would be equivalent to a Cr bcc underlayer. Thus, persons of ordinary skill would have found *no* suggestion in the cited references to use a RuAl underlayer to produce oriented media,

particularly when Bian uses RuAl and did not produce oriented media. Note that page 6, lines 15 and 16 define “oriented media” as “the media with OR-Mrt more than 1, e.g. more than 1.05.” Thus, “oriented media” was inherently recited in claim 2. Yet, to make it explicit that the claimed recording medium is “oriented,” claims 1 and 11 have been amended to recite “wherein the non-magnetic substrate is mechanically textured and OR-Mrt of the magnetic recording medium is more than about 1.05, thereby the magnetic recording medium is an oriented medium.”

Even assuming that the Examiner has established a *prima facie* case of obviousness, which Applicants deny, the Federal Circuit in *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991) clearly stated that an Applicant could rebut a *prima facie* case of obviousness by a showing of *unexpected results*. As a result of this invention, Applicants found the *unexpected result* that a RuAl underlayer could produce an OR-Mrt of greater than 1.0. This unexpected result is even recited in the claims. Please note, “Consistent with the rule that all evidence of nonobviousness *must* be considered when assessing patentability, the PTO *must* consider comparative data in the specification in determining whether the claimed invention provides unexpected results.” *In re Soni*, 54 F.2d 746, 34 USPQ2d 1684 (Fed. Cir. 1995) (emphasis added).

Claims 4, 7, 8, 17 and 19 were rejected as being obvious over Bian in view of Chen. Claim 5 was rejected as being obvious over Bian in view of Chen and Abarra. Claim 18 was rejected as being obvious over Bian in view of Chen, Abarra and Okumura. These rejections are respectfully traversed.

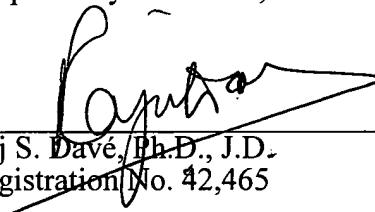
Claims 4, 5, 7, 8, and 17-19 depend directly or independently from claims 1 or 11, which should now be allowable. Thus, claims 4, 5, 7, 8, and 17-19 should be allowable.

In light of this Amendment, a Notice of Allowance is respectfully solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952**, referencing docket number 146712002800. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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